REMARKS

Claims 1-11, 19-22 and 26-47 are pending in the application and claims1-2, 4-6, 8-11, 21-22, 26, 28, 29, 31 and 33 stand rejected.

Objections to the claims

Claims 1 and 37 stand objected to for containing typographical errors. These typographical errors have been addressed via amendments presented herein and the Examiner requested to kindly withdraw this objection.

Rejection under 35 U.S.C §112

Claim 1 stands rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner finds that the recitation of "at least one of:" in the claim is unclear as to whether it refers to all following limitations or just the secure executor and the secure loader. Claim 1 has been amended herein to make it clear that this recitation refers to only the secure executor and the secure loader, and Applicants respectfully submit that this rejection is now moot.

Rejection under 35 U.S.C §103

Claims 1-2, 4-6, 8-11, 21-22, 26, 29, 31 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,697,948 to Rabin et al. in view of U.S. Pat. No. 5,991,399 to Graunke et al. In particular and with respect to claim 1, the Examiner finds that Rabin teaches all claimed limitations with the exception of a trusted module as claimed, further finds that Graunke teaches precisely this limitation, and concludes that it would have been obvious to the skilled person to use the tamper-resistant module (key module) of Graunke with the platform of Rabin to ensure the authenticity of the executor and that access to the content is allowed. Applicants respectfully disagree.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP §2142. Furthermore, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some *rational underpinning* to support the legal conclusion of obviousness." *In re Leonard Kahn*, 04-1616, *p. 15 (Fed. Cir., March 22, 2006) [emphasis added]. The Examiner's assertion of obviousness does not meet this requirement as it does not state where in the references themselves the skilled person can find the requisite motivation and, more importantly, the Examiner's allegation of motivation is self-contradictory in view of his assertion that Rabin teaches means for integrity checking the license-related code and preventing the license-related code from being loaded if the integrity check fails. If, by the Examiner's own admission, Rabin teaches means for integrity checking and preventing the code form being loaded, then why would the skilled person possibly be motivated to look to Graunke's tamper-resistant module and consider implementing it with the platform of Rabin to ensure the authenticity of the executor and that access to the content is allowed? In light of the Examiner's own interpretation of Rabin, the tamper-resistant module of Graunke is completely redundant.

"Second, there must be a reasonable expectation of success... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142. The Examiner has offered not one single detail as to how exactly the skilled person would go about using the tamper-resistant module of Graunke with the platform of Rabin to ensure the authenticity of the executor and that access to the content is allowed. As already noted in Applicants' previous submission, Graunke does not teach or suggest any of the claimed limitations for checking the integrity of license-related code. What Graunke does teach is a "tamper resistant key module 52" that holds a conditional use private key to allow digital content to be played on a "trusted player 42." It is certainly not apparent how the approach of Graunke could readily be combined with the unique software vendor tag approach of Rabin, and the Examiner has not supplied any of the requisite details for supporting a reasonable expectation of success.

"Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2142. Contrary to the Examiner's assertion, Rabin does not in fact teach means for integrity checking the license-related code and preventing the license-related code from being loaded if the integrity check fails. Specifically, the Examiner asserts that Rabin teaches means storing license-related code comprising at least one of a secure executor for checking whether the platform or a user thereof is licensed to use particular data and for providing an interface for using the date and/or for monitoring its usage, and a secure loader for checking whether the platform or a user thereof is licensed to install particular data and/or for checking for data integrity before installation, by teaching the supervising program (SP) 209 which runs on the user's device (i.e. computer platform) to ensure that no unauthorized use of software takes place (abstract of Rabin). The Examiner then further asserts that Rabin teaches means for integrity checking the license-related code and preventing the license-related code from being loaded if the integrity check fails at col. 40 ll. 53-65, which discusses how the supervising program rejects an instance of software if an invalid tag is returned by a tag server – "where the Examiner interprets rejecting the instance as preventing the code from being loaded if the tag fails the integrity check." Applicants respectfully point out that these two statements are contradictory – in the first statement the Examiner asserts that the supervising program corresponds to the claimed license-related code, and in the second statement the Examiner is clearly considering the software instance (i.e. the software product provided by the software vendor and the use of which is monitored by the supervising program) to correspond to the claimed license-related code. Thus, Applicants respectfully ask – which one is it? Claim 1 recites means for integrity checking and preventing the license-related code from being loaded if the integrity check fails – there is absolutely nothing in Rabin that discusses means for preventing the supervising program from being loaded in some sort of check fails; in fact, there is no discussion of any sort of checks performed on the supervising program whatsoever. And, of course, there is no discussion anywhere in Rabin of the software products monitored by the supervising program having any of the claimed limitations of the license-related code. Applicants thus respectfully submit that the Examiner has misinterpreted the plain teaching of Rabin and appears to have conflated the supervising program with the software products the use of which it is intended to monitor.

In view of the above, Applicants respectfully submit that the Examiner has failed to make a properly substantiated 103 rejection of claim 1 in view of Rabin and Graunke and respectfully request him to kindly reconsider and pass this claim to issue.

Claims 2, 4-6, 8-11, 21-22, and 26 depend from claim 1. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of claim 1, Applicants submit that claims 2, 4-6, 8-11, 21-22, and 26 are also allowable at least by virtue of their dependency on claim 1.

Claim 29 is an apparatus claim that includes the limitations discussed above with respect to claim 1. Thus, Applicants submit that the above discussion of claim 1 is equally probative of the novelty and non-obviousness of claim 29, and respectfully request the Examiner to reconsider and pass claims 29 to issue as well.

Claims 31 and 33 depend from claim 29, and thus Applicants submit that these claims are also allowable at least by virtue of their dependency on claim 29.

Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,390,297 to Barber et al. in view of U.S. Pat. No. 6,266,416 to Sigbjornsen et al. Specifically, the Examiner finds that Barber teaches all claimed limitation but for trusted modules containing the license, that Sigbjornsen teaches software licenses stored in trusted modules (smart cards) and that smart cards provide flexibility and are considered the most tamper-proof protection of data, and opines that it would have been obvious to the skilled person to store the licenses of Barber in the smart cards of Sigbjornsen to protect them from tampering. With all due respect, Applicants traverse this holding as being clearly erroneous in view of the plain disclosure of these two references.

With renewed reference to the three requirements for an obviousness rejection noted previously, Applicants submit that there is in fact not only no motivation to combine Barber with Sigbjornsen as alleged by the Examiner, but that the references actually teach against this very combination. Barber is directed to the use of licenses on an active computer network, and requires nodes (and licenses) to be attached to the network to manage the licenses. Sigbjornsen, on the other hand, is a very different system that is personal to the user and his individual smart

card. The smart cards of Sigbjornsen can clearly be removed from or added to a network node at will and thus their use would render a scheme such as that of Barber (which needs to be able to access, over the network, all licenses or license tokens) simply unworkable. Thus, Applicants submit that there is in fact no motivation to combine these references as alleged by the Examiner nor any inkling of a reasonable expectation of success on the part of the skilled person in so combining these references. Applicants thus respectfully submit that the Examiner has failed to make a properly substantiated 103 rejection of claim 28 in view of Barber and Sigbjornsen and respectfully request him to kindly reconsider and pass this claim to issue as well.

Applicants acknowledge with gratitude the Examiner's indication of allowability as to claims 3, 7, 19, 20, 27, 30, 32, and 43-47 but, as fully detailed above, they believe that all claims as currently pending are allowable over the art on record.

Regarding the prior art made of record by the Examiner but not relied upon, Applicants believe that this art does not render the pending claims unpatentable.

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.
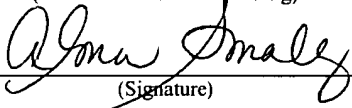
I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

Respectfully submitted,

September 11, 2006
(Date of Transmission)

Alma Smalling
(Name of Person Transmitting)
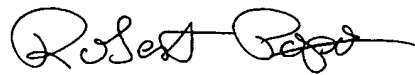
(Signature)

9/11/06
(Date)

Robert Popa
Attorney for Applicants
Reg. No. 43,010
LADAS & PARRY
5670 Wilshire Boulevard, Suite 2100
Los Angeles, California 90036
(323) 934-2300 voice
(323) 934-0202 facsimile
rpopa@ladasparry.com